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BAKER BOTTS LLP, 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			NORMAN, SAMICA L	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/774,058

Filing Date: February 06, 2004

Appellant(s): MAHANEY ET AL.

James Mahaney and Peter Carlson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 4, 2011 appealing from the Office action mailed November 15, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application No. 11/051,986 is a continuation in part of the instant application has been assigned Appeal No. 2010-002444.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claim 50 is rejected.

Claims 1-14, 19-28 and 36-47 are cancelled.

Claims 15-18, 29-35, 48 and 49 are withdrawn.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

20020188540

Fay et al.

6-2001

Orth, "Retirement Planning for Married Couples: Distribution Differences," Employee Benefit Plan Review, volume 57, Issue 5 (November 2002), page 15.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fay et al., U.S. PG-Pub No. 2002/0188540 (reference B on the attached PTO-892) in view of Orth, "Retirement Planning for Married Couples: Distribution Differences" (reference X on the attached PTO-892).

3. As per claim 50, Fay teaches a non-transitory tangible computer-readable storage medium encoded with computer-readable instructions for calculating income streams for a husband and a wife that, when executed by one or more computer systems, performs steps comprising: receiving information about the husband, including the husband's age or birthdate (see paragraph 0038, lines 8-14); receiving information about the wife, including the wife's age or birthdate (see paragraph 0038, lines 8-14); calculating a projected retirement income for the husband and the wife in a bridge scenario, the projected retirement income in the bridge scenario including an estimate of yearly inflation-adjusted after-tax income (see paragraph 0040, lines 1-11) from: a bridge annuity for the husband beginning at an expected retirement age for the husband and ending at a deferred age for the husband (see paragraph 0038, lines 8-14); calculating a projected retirement income for the husband and the wife using an alternative funding approach (see paragraph 0038, lines 14-21); comparing the

calculated projected retirement income for the husband and the wife in the bridge scenario to the projected retirement income for the husband and the wife using the alternative funding approach (see paragraph 0043, lines 1-10).

Fay et al. does not explicitly teach deferred Social Security for the husband beginning at the deferred Social Security age for the husband; a bridge annuity for the wife beginning at an expected retirement age for the wife and ending at a deferred Social Security age for the wife; and deferred Social Security for the wife beginning at the deferred Social Security age for the wife. Orth teaches deferred Social Security for the husband beginning at the deferred Social Security age for the husband; a bridge annuity for the wife beginning at an expected retirement age for the wife and ending at a deferred Social Security age for the wife; and deferred Social Security for the wife beginning at the deferred Social Security age for the wife (see page 3, paragraph 1). It would have been obvious to one of ordinary skill in the art at the time of the since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Furthermore, one of ordinary skill in the art would have motivated to incorporate this feature for the purpose of postponing tax being paid on Social Security payments by using other retirement income first (see page 4, paragraph 1 of Orth).

(10) Response to Argument

Appellant Argues (1): There is no *prima facie* obviousness for calculating retirement income for a husband and wife, in part, from a bridge annuity ending at a deferred Social Security age for the husband.

Examiner's Answer (1): The references being used in the 35 U.S.C. 103(a) Rejection, Fay et al. and Orth, are both considered analogous art. Fay teaches that the annuity payout begins at retirement age and continues to payout until a defined period which is defined by the user (paragraphs 0027 and 0036). Paragraph 0027 recites an annuity that is a flexible tax-deferred retirement product that can provide long time earnings for an investor (husband and wife). The investor can choose a payout option that best meets the user's needs for income such as a plurality of income payments paid out over a certain period of time (bridge annuity). Therefore, the income is calculated based on the user's desired payments. Paragraph 0036 teaches the user predetermines before purchasing the retirement annuity a desired retirement date and a schedule of premium payments. Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made, based upon the teaching(s) of Fay, that user can select the defined ending age as that of a deferred Social Security age.

Appellant Argues (2): There is no *prima facie* obviousness for calculating retirement income for a husband and wife from two different bridge annuities, one of which is a bridge annuity for the wife ending at a deferred Social Security age for the wife. Fay-Orth combination fails to disclose "calculating a projected retirement income for the husband and wife in a bridge scenario, the projected retirement income in the bridge scenario including an estimate of yearly inflation-adjusted after-tax income from....a bridge annuity for the wife beginning at an expected retirement age for the wife and ending at a deferred Social Security age for the wife.

Examiner's Answer (2): As stated in Examiner's Answer (1), the system of Fay et al. teaches a user (husband or wife or both) investing in an annuity that pays out over a user defined schedule.

Fay et al. further teaches calculating a guaranteed retirement income amount to be paid out a certain date or age (paragraph 0016). Paragraph 0016 recites the retirement income amount includes a predetermined guaranteed minimum retirement income if the received premium payments are received according to a predetermined premium payment schedule. Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made, based upon the teaching(s) of Fay, that the guaranteed amount would already reflect any taxes.

Appellant Argues (3): There is no *prima facie* obviousness for comparing projected retirement income for the husband and the wife in a bridge scenario to projected retirement income for the husband and the wife using an alternative funding approach.

Examiner's Answer (3): In paragraph 0040 the quote calculator outputs can output the retirement income amount. In paragraph 0043 the user is given different options (alternative) that includes adding riders but also includes a lump sum option, a buy down premium payment, etc. The system outputs a quote(s) with the cost breakdown that includes a user's retirement income amount and any other options the user specifies.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Samica Norman

/SAMICA L NORMAN/

Primary Examiner, Art Unit 3693

Conferees:

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